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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,878	08/31/2000	Theodore M. Taylor	4372US (99-1187)	3858

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EXAMINER

ELEY, TIMOTHY V

ART UNIT PAPER NUMBER

3724

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/652,878

Applicant(s)

TAYLOR, THEODORE M.

Examiner

Timothy V Eley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 40-54 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,19,21 and 51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-48 is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,9,11,13,17,18,22,49,50 and 52 is/are rejected.
- 7) ☒ Claim(s) 4,8,10,12,14-16,20,23,53 and 54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,2,6,7,9,11,13,17,18, and 22 are rejected under 35

U.S.C. 102(e) as being anticipated by Walker'800 et al.

a. Walker et al is explained in the rejection beginning on page 2 of paper number 15. However, it should be noted that Walker et al can be considered to have a substantially planar subpad since each segment 457 is substantially planar and functions as a subpad(see column 9, lines 16-20.

b. Regarding claim 9, the platen 420 inherently comprises a metal.

3. Claims 17,18,49,50, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Vander Voort, as applied in the rejection on page 3 of paper number 15.

***Response to Arguments***

4. Applicant's arguments filed January 30, 2004 have been fully considered but they are not persuasive.

a. Applicant argues that Walker does not expressly or inherently describe, or anticipate the substantially planar subpad recited. However, as explained above, Walker et al can be considered to have a substantially planar subpad since each segment 457 is substantially planar and functions as a subpad as broadly recited by applicant.

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b. Applicant argues that Vander Voort lacks any express or inherent description of a "substantially planar subpad which is . . . not configured to be secured to the polishing". It should be noted, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Furthermore, applicant's invention could also be used to support a magnetic subpad which is secured to a polishing pad, even though applicant recites that the subpad is not configured to be secured relative to the polishing pad. Applicant is merely reciting a subpad support upon which any type of subpad may be used.

c. Also, the examiner does not understand why applicant insists on arguing the point of "polishing" preparation element 70 not being a polishing pad. However, for applicant's information, "pad" is defined as: 1 a: a thin flat mat or cushion (Webster's New Collegiate Dictionary).

***Allowable Subject Matter***

5. Claims 40-48 are allowed.

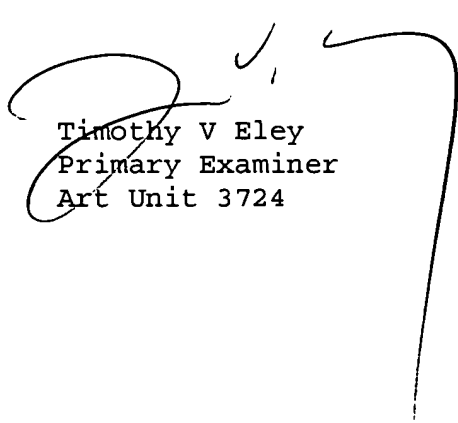
6. Claims 4,8,10,12,14-16,20,23,53, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V Eley whose telephone number is 703-308-1824. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Timothy V Eley  
Primary Examiner  
Art Unit 3724

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